

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Application No.: 10/579,654
Filing Date: May 18, 2006
Applicant: Paul Meredith et al.
Group Art Unit: 1794
Confirmation No.: 9357
Examiner: Ling X. Xu
Title: Silica Films and Method of Production Thereof
Attorney Docket: 6106-000006/US/NP

Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Sir:

This paper is in response to the Office Action mailed November 14, 2008, concerning the above-caption application. The shortened period for response to this Office Action extends until December 15, 2008.

In the Office Action, the Examiner required restriction under 35 U.S.C. 121 in the present application to one of the following inventions:

Group I – Claims 1-18 and 34 drawn to a method of forming coated substrate.

Group II – Claims 19-21 drawn to a method of forming a formulation.

Group III – Claim 22 drawn to a formulation.

Group IV – Claims 23-28 and 30-33 drawn to a silica film and coating.

Group V – Claim 29 drawn to a use of the silica film.

Upon further review of the application as filed, it appears that an incorrect set of claims was considered by the Examiner when making this restriction requirement. The pending application includes 29 claims as presented during the international phase of the application, and in particular the amendments made pursuant to Article 34 of the Patent Cooperation Treaty. These claims were submitted in the national phase filing of this application pursuant to 35 U.S.C. 371 on May 18, 2006 and appear in PAIR as a 7-page document identified as 371P. For clarity, these claims are attached at Attachment A of this response.

On December 15th, Applicant's representative conducted an interview with Examiner Xu during which this issue was discussed. The Examiner agreed that the claims considered in the restriction requirement were not the same claims as presented in the application filed in the U.S. pursuant to 35 U.S.C. 371. The Examiner further noted that the claims considered in the restriction requirement were different from the claims presented by Applicant in the Request for Participation in the PPH Pilot Program Between IPAU and USPTO filed on November 14, 2008. In an effort to correct this error Applicant's representative agreed to provide a written response noting the error and requesting reconsideration of the restriction requirement without making an election.

In view of the facts set forth above, Applicant respectfully requests (1) that the Examiner withdraw the prior restriction requirement on the basis that it does not comport with the claims as presently pending in this application and (2) that the restriction is expunged from the record of the present application. Applicant further

requests that the claims of the present application be corrected to properly reference the claims as originally filed (and reproduced at Attachment A hereto).

Accordingly, it is believed that the outstanding Office Action has been fully complied with herein. If the Examiner has any questions or would like to personally discuss this application, she is invited to contact either of the undersigned attorneys at the telephone number listed below.

Respectfully submitted,

Dated: DECEMBER 15, 2008

/ David A. McClaughry /
By: _____
David A. McClaughry
Reg. No. 37,885

HARNESS, DICKEY & PIERCE, P.L.C.
P.O. Box 828
Bloomfield Hills, Michigan 48303
(248) 641-1600